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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/536,916

05/31/2005

Stein Kuiper

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

JONES, JAMES

ART UNIT

PAPER NUMBER

2873

MAIL DATE

DELIVERY MODE

05/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/536,916

Applicant(s)

KUIPER ET AL.

Examiner

James C. Jones

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/7/2006</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Examiner's Comments

For applicant's information, apparently an originally submitted set of claims on May 31, 2005 presented claims 1-20. The amendment to the claims of May 31, 2005 only addressed claims 1-18. For applicant's information, all claims need to be addressed in amendments. It is suggested that in reply to this office action, whether the claims are amended or not, that applicant resubmit the claims addressing all claims including claims 19-20. For purposes of examination it is presumed that claims 19-20 have been cancelled.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 4/7/2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

The specification is objected to because the applicant has not set forth a reference to the background of the invention, summary of the invention, brief description of the drawings, and the detailed description of the preferred embodiments.

Furthermore, the following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use. The following section headings are preferably used within the specification where appropriate and each of the

numbered items should appear in upper case, without underlining or bold type, as section headings.

1. Background of the Invention.
2. Summary of the Invention.
3. Brief Description of the Drawings.
4. Detailed Description of the Preferred Embodiments.

Specifically, applicant has not included any of the guidelines listed above and it is suggested that they be inserted into the specification where appropriate to provide additional clarity.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abitbol (20040100617) hereafter '617 in view of Berge et al (6369954) hereafter '954.

Regarding **claims 1 and 15** '617 discloses an ophthalmic apparatus for the testing of eye deviation of a patient's eyes(fig.2,abstract,par.[0014]), said apparatus comprising: a) a variable lens having an optical axis and refractive characteristics which cause alterations in direction of rays of light passing through the lens along predetermined incident paths(fig.2 or 3,par.[0024][0027][0058]-[0060] the transmissive adaptive optical element "24" or "42" as the "variable lens"); b) control means for controlling the refractive characteristics of said variable

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lens, during the measurement of a patient's eye deviation(fig.2,par.[0058]-[0060] the control unit “26” as the “control means”); and c) output means for outputting a data value indicative of a measured eye deviation for the patient(fig.2,par.[0058] output “32” as the “output means”), but does not specifically disclose the variable lens comprising a meniscus and a plurality of electrodes spaced about said optical axis, wherein said control means is adapted to achieve different meniscus shapes by a variation of a pattern of voltages applied across said plurality of electrodes, wherein said meniscus shapes are lens shapes having variable refractive characteristics and including at least approximately spherical or aspherical and at least approximately anamorphic lens shapes. ‘954 teaches that in a lens system that uses an applied voltage to vary the optical power of a variable lens(fig.3 or fig.6,abstract,col.3,ln.33-39) that it is desirable for a variable lens to comprise a meniscus(fig.3,col.3,ln.33-39 the curve in the surface of liquid “11” as the “meniscus”) and a plurality of electrodes spaced about said optical axis(fig.3 or fig.6,col.4,ln.21-53,col.5,ln.28-64, “75” “77” “78” “79” “17” as the “electrodes” and “O” as the “optical axis”) wherein said control means is “adapted to” achieve different meniscus shapes by a variation of a pattern of voltages applied across said plurality of electrodes, wherein said meniscus shapes are lens shapes having variable refractive characteristics and including at least approximately spherical or aspherical and at least approximately anamorphic lens shapes(fig.3 or fig.6,col.4,ln.21-53,col.5,ln.28-64) for the purpose of providing a variable lens with sufficient utilization, efficient use, easy employment, simplified manufacturing and focus variation(col.1,ln.46-49). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have included the variable lens taught by ‘954 in the lens system of ‘617 since ‘954 teaches that in a lens system that uses an

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applied voltage to vary the optical power of a variable lens that it is desirable for a variable lens to comprise a meniscus and a plurality of electrodes spaced about said optical axis wherein said control means is "adapted to" achieve different meniscus shapes by a variation of a pattern of voltages applied across said plurality of electrodes, wherein said meniscus shapes are lens shapes having variable refractive characteristics and including at least approximately spherical or aspherical and at least approximately anamorphic lens shapes for the purpose of providing a variable lens with sufficient utilization, efficient use, easy employment, simplified manufacturing and focus variation.

Note: it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding **claim 2**, '617 and '954 discloses and teach as set forth above and '954 further teaches that in a lens system which uses an applied voltage to vary the optical power of a variable lens that it is further desirable to also include a meniscus separating a layer of a first fluid and a layer of a different, second fluid for the purpose of providing a variable lens with sufficient utilization, efficient use, easy employment, and simplified manufacturing (fig.3 or fig.6 col.1,ln.46-49). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have included the variable lens taught by '954 in the lens system of '617 since '954 further teaches that in a lens system which uses an applied voltage to vary the optical power of a variable lens that it is further desirable to also include a meniscus separating a layer of a first fluid and a layer of a different, second fluid for the purpose of

providing a variable lens with sufficient utilization, efficient use, easy employment, and simplified manufacturing.

Regarding **claim 3**, '617 and '954 discloses and teach as set forth above and '954 further teaches that in a lens system which uses an applied voltage to vary the optical power of a variable lens that it is further desirable to also include refractive characteristics of the lens shapes that are variable by variation of said pattern of voltages applied across the electrodes for the purpose of providing focus variation(fig.3 or 6,col.3,ln.33-39,col.4,ln.44-53). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have included the variable lens taught by '954 in the lens system of '617 since '954 further teaches that in a lens system which uses an applied voltage to vary the optical power of a variable lens that it is further desirable to also include refractive characteristics of the lens shapes that are variable by variation of said pattern of voltages applied across the electrodes for the purpose of providing focus variation.

Regarding **claim 4**, '617 and '954 discloses and teach as set forth above and '954 further teaches that in a lens system which uses an applied voltage to vary the optical power of a variable lens that it is further desirable to also include wherein said plurality of electrodes comprise one or more pairs of electrodes, and the members of each said pair are located on opposite sides of said optical axis for the purpose of varying the shape of the lens thereby providing focus variation(fig.3 or 6,col.3,ln.33-39,col.4,ln.44-53). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have included the variable lens taught by '954 in the lens system of '617 since '954 further teaches that in a lens system which uses an applied voltage to vary the optical power of a variable lens

that it is further desirable to also include wherein said plurality of electrodes comprise one or more pairs of electrodes, and the members of each said pair are located on opposite sides of said optical axis for the purpose of varying the shape of the lens thereby providing focus variation.

Regarding **claim 5** '617 and '954 discloses and teach as set forth above and '617 further discloses, the apparatus according to claim 1, comprising means for rotating the variable lens about the optical axis(fig.6a-6b,par.[0065]).

Regarding **claim 6**, '617 and '954 disclose and teach as set forth above wherein said control means is "adapted to" rotate the pattern of applied electrode voltages about the optical axis. Note: it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding **claim 7** '617 and '954 discloses and teach as set forth above and '954 further teaches that in a lens system which uses an applied voltage to vary the optical power of a variable lens that it is further desirable to also include a plurality of electrodes that include a substantially cylindrical electrode configuration for the purpose of varying the shape of the lens thereby providing focus variation(fig.3 or 6,col.3,ln.33-39,col.4,ln.30-53). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have included the variable lens taught by '954 in the lens system of '617 since '954 further teaches that in a lens system which uses an applied voltage to vary the optical power of a variable lens that it is further desirable to also include a plurality of electrodes that include a substantially cylindrical electrode configuration for the purpose of varying the shape of the lens thereby providing focus variation.

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Regarding **claims 8 and 18** '617 and '954 discloses and teach as set forth above and '617 further discloses, the apparatus according to 1, wherein said output means is arranged to output a data value to be included in at least part of an ophthalmic prescription to be produced for the patient(fig.2,par.[0019][0058] "32" as the "output means").

Regarding **claims 9 and 16** '617 and '954 discloses and teach as set forth above and '617 further discloses, the apparatus according 1, further comprising a testing object comprising ophthalmic indicia for viewing by a patient during the testing of eye deviation(fig.2,par.[0058][0059] test card "22" as the "testing object").

Regarding **claim 10** '617 and '954 discloses and teach as set forth above and '954 further teaches that in a lens system which uses an applied voltage to vary the optical power of a variable lens that it is further desirable to also include at least approximately anamorphic lens shapes that include at least approximately cylindrical and at least approximately spherocylindrical lens shapes for the purpose of providing sufficient utilization, efficient use, easy employment, and simplified manufacturing of the variable lens(fig.3 and fig.6,col.1,ln.46-49). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have included the variable lens taught by '954 in the lens system of '617 since '954 further teaches that in a lens system which uses an applied voltage to vary the optical power of a variable lens that it is further desirable to also include at least approximately anamorphic lens shapes that include at least approximately cylindrical and at least approximately spherocylindrical lens shapes for the purpose of providing sufficient utilization, efficient use, easy employment, and simplified manufacturing of the variable lens.

Regarding **claim 11** '617 and '954 discloses and teach as set forth above, the apparatus according to 1, wherein said control means is "adapted to" provide, in one refractive state, a lens shape having a focal power of a negative value. Note: it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding **claim 12** '617 and '954 discloses and teach as set forth above and '954 further teaches that in a lens system which uses an applied voltage to vary the optical power of a variable lens that it is further desirable to also include an apparatus according to claim 1, wherein said control means is "adapted to" provide, in one refractive state, a lens shape having a focal power of a positive value for the purpose of providing focus variation(fig.3 and 6). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have included the variable lens taught by '954 in the lens system of '617 since '954 further teaches that in a lens system which uses an applied voltage to vary the optical power of a variable lens that it is further desirable to also include an apparatus according to claim 1, wherein said control means is "adapted to" provide, in one refractive state, a lens shape having a focal power of a positive value for the purpose of providing focus variation. Note: it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding **claim 13** '617 and '954 discloses and teach as set forth above and the prior art disclosed in '617 further teaches a head mounting means for positioning various lenses in a

desired configuration relative to the patient's eyes for the purpose of providing a hands free visual acuity examination system(fig. 1, par. [0002][0056] trial frames "14" as the "head mounting means"). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have included the variable lens taught by '954 in the form of a head mounted system since the prior art disclosed in '617 further teaches a head mounting means for positioning various lenses in a desired configuration relative to the patient's eyes for the purpose of providing a hands free visual acuity examination system.

Regarding **claim 14** '617 and '954 discloses and teach as set forth above and '617 further discloses, the apparatus according to 1, further comprising one or more non-variable solid lenses which are positionable so as to share the optical axis of said variable lens(fig. 3, par. [0060]-[0061] lens "40" as the "solid lens").

Regarding **claim 17** '617 and '954 discloses and teach as set forth above and '617 further discloses, a method according to claim 15, wherein the data value indicative of a measured eye deviation for the patient is recorded when the patient can view the ophthalmic indicia at a level of ability at least matching a predetermined threshold of viewing ability(fig. 2 par. [0058]).

Conclusion

Blum et al.(6733130), Feenstra et al.(20050253779), and Nose et al.(4887897) are being cited herein to show a reference(s) that disclose some similar features to that of the claimed invention.

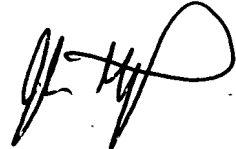
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James C. Jones whose telephone number is (571) 270-1278. The examiner can normally be reached on Monday thru Friday, 8 a.m. to 5 p.m. est. time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James C. Jones 5/23/2007
JCJ


JORDAN SCHWARTZ
PRIMARY EXAMINER